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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,310	04/29/2005	Kaoru Okakura	Q87626	2360
23373	7590	07/11/2007		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER CHOWDHURY, IQBAL HOSSAIN	
			ART UNIT	PAPER NUMBER
			1652	
			MAIL DATE	DELIVERY MODE
			07/11/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/533,310

Applicant(s)

OKAKURA ET AL.

Examiner

Iqbal H. Chowdhury, Ph.D.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 3-9 and 12-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-2, 10-11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Application Status*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/27/2007 has been entered.

Claims 1-21 are currently pending.

In response to a previous Office action, a final requirement (mailed on 10/11/2006), Applicants filed a response and amendment received on 1/11/2007 is acknowledged. Claim 1 is amended and claims 4-9 and 12-21 are remain withdrawn.

Claims 1-3, and 10-11 are pending in the instant Office action.

Applicants' arguments filed on 1/11/2007, have been fully considered but are not deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Regarding lack of unity, which was made **FINAL** in the previous office action mailed on 4/10/2006, the applicants again argue stating that because claim 1 is amended by deleting "one or plural amino acids are added to or deleted from N-terminus of the amino acid sequence of SEQ ID NO: 1", that SEQ ID NO: 1 is linking feature of all the claims, to rejoin i.e. all the claims which are dependent on claim 1 should be rejoined and claiming that lack of unity no more exists. This is not found persuasive because such amendment does not change core point that the claims lack unity as they does not share any technical feature except that they are all variants of

the polypeptide comprising SEQ ID NO: 1 that is unmodified, which is known in the art (WO01/90375). As such structure of SEQ ID NO: 1 is not a special technical feature. WO01/90375 teach a protein, which is 100% identical to SEQ ID NO: 1 (see sequence alignment). As discussed in the Restriction requirement (mailed on 12/29/2005) the polynucleotide encoding a polypeptide cellulase of Group II and polypeptide cellulase of Group I are each unrelated and chemically distinct entities. The only shared technical feature of these groups is that they all relate to polynucleotide encoding a polypeptide cellulase or polypeptide cellulose. However, this shared technical feature is not a "special technical feature" as defined by PCT Rule 13.2 as it does not define a contribution over the art. According to the search report (PCT form 210), a DNA encoding a cellulase as well as cellulase polypeptide is known in the art (WO01/90375, see IDS). Thus, a DNA encoding a cellulase protein or a cellulase protein itself does not make contribution over the prior art. Therefore, lacks unity of invention.

For the reasons above and as discussed in length in the previous office actions, the requirement is maintained.

In addition, applicants elected Group I, and SEQ ID NO: 3 (modified at position 162 of SEQ IDS NO: 1) for prosecution without traverse in the response filed on 1/27/2006. It is noted that there was an error to include claim 3 in the elected group, however, claim 3 which encompasses SEQ ID NO: 4 (nonelected by the applicant (response 1/27/2006)). Therefore, claim 3 is withdrawn as nonelected inventions.

Claims 1-2, and 10-11 are under consideration and will be examined herein.

### ***Claim Objections***

Claims 1, 10 and 11 are objected to as encompassing non-elected subject matter i.e., claim continue to recites "substitution at position 166 of SEQ ID NO: 1", which is corresponds to SEQ ID NO: 4. Appropriate correction is requested.

Claim 3 is objected to as depending from an objected claim. Appropriate correction is requested.

Examiner proposed an Allowance of claims 1-2 and 10-11 with an Examiners amendment for claim 1 and canceling nonelected claims but applicants declined the proposed allowance.

### ***Conclusion***

#### **Status of the claims:**

Claims 1-21 are pending.

Claims 3-9 and 12-21 remain withdrawn.

Claims 1-2 and 9-10 are objected to but would be allowable if claim 1 is corrected against the objection raised by the Examiner.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Iqbal Chowdhury whose telephone number is 571-272-8137. The examiner can normally be reached on 9:00-5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1652

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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